

REMARKS

Because claims 2-5, 11 and 12 were cancelled, claims 1, 6-10 remain in this application, with claims 1 and 8 being independent. In the office action, each of claims 1-12 stand rejected. In view of the above amendments and following remarks, the claims should now be allowable.

Rejection in view of the Barbaccia patent

Claims 1-8 stands rejected under 35 U.S.C. §102(b) as being anticipated by the Barbaccia patent U.S. Patent No. 5,991,927 ("Barbaccia"). A rejection for anticipation under section 102 requires that all the elements of an invention, as stated in a patent claim, are identically set forth, in a single prior art reference. See *Gechter v. Davidson*, 116 F.3d 1454, 1457 43 USPQ2d 1030, 1032 (Fed. Cir. 1997).

Although, the reference cited contains some elements which may be similar, the reference is not identical. Because Barbaccia does not disclose or suggest each of the claimed elements in this claim, the rejection should be withdrawn.

Specifically, Barbaccia does not disclose nor suggest an elongated portion of the stabilizing support arm that is perpendicularly orientated to the visor when inserted into the device channel, nor does it disclose an elongated appendage which is adapted to prevent rotation of the headwear.

First and second bill locking portion 26, 27 are apparently relied on as the recited stabilizing arm, the locking portions 26, 27 being located at the first and second terminal ends 24, 25. The bill locking portions 26, 27 are disclosed as frictionally holding the bill 12 against the bill

shaping wall 22. However, there is no stabilizing arm. Although, the locking portions 26,27 have a grooved interior for receiving the visor, the exterior of the locking portions is not disclosed as supporting the visor and limiting the rotation of the headwear. Furthermore, bottom portions of the first and second bill locking portions 26, 27 of the cited reference are not and cannot provide the stability disclosed in the present invention. In fact, the cited reference teaches away from the present invention. As disclosed in Fig. 1, the bottom surfaces of the bill locking portions 26 and 27 are curved promoting rotation of the headwear. The present invention discloses a stabilizing arm, adapted to prevent rotation of the headwear. This aspect of the present invention is not present in the cited reference nor is it suggested by the cited reference.

In addition, the present invention as amended, is adapted to display a graphical image on the front surface of the device. The cited reference, can not display a graphical image on the front surface because the cited reference discloses the use of a plastic sheet for forming the bill shaping wall. As disclosed in Figs. 1-3 of the cited reference, the plastic sheet extends a substantial distance along the visor surface. The cited reference does disclose various indicia stored in the shaping device, along the surface of the upper bill shaping wall. The present invention, however, provides a front surface for visual indicia, the visual indicia being divided by the channel. This aspect is not disclosed nor suggested by the cited reference. Because the cited reference does not include each and every limitation of the present invention, applicant respectfully requests that the objection be withdrawn and that the application be allowed to issue.

The examiner, rejected to claims 9-12 as being obvious under 35 U.S.C. § 103(a) in light of Barbaccia. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) sets forth the four steps for establishing a background for determining obviousness and summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Examiner failed to follow these four steps for establishing a background for determining obviousness. As described above, the structure of the cited reference is identical to the present invention. With respect to the graphical image, the graphical image on the cited reference is disclosed as stored within the shaping device. However, the present invention, teaches a graphical indicia being located along the front surface of the shaping device. The cited reference, in fact teaches away from the use of the graphical image on the front surface, suggesting that the graphical image should be stored within the shaping device. It would not have been obvious to place the graphical image on the front surface which includes the upper and lower surfaces separated by the channel or along the stabilizing arm in the present invention.

As discussed above, the current invention is different from the prior art, specifically Barbaccia. As amended, Claims 1, 6-10 provides for athletic headwear device with a front separated from a back by a depth, the device including a stabilizing member and a channel,

the front being adapted for displaying a graphical image divided by the channel. This arrangement is an improvement over the referenced device in that it provides more stability and limits the rotation of the device. This improvement, among others, is an improvement over the cited reference which is not disclosed nor suggested in the cited reference.

Even if the Examiner had shown evidence that it would have been obvious to one skilled in the art to try combining the device in Barbaccia with devices in other references, “this is not the standard of 35 U.S.C. § 103.” *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). While prior art references may provide a means to combine, or examples of related combinations, if they do not suggest the advantages gained by the combination of the claimed invention they do not provide a motivation to combine. “A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). The references must teach the advantage in order to suggest or motivate, not just the possibility of combination or the suggestion to try. The Federal Circuit “has consistently refused to recognize ‘obvious to try’ rejections.” *In re Goodwin*, 576 F.2d 375, 377 (CCPA 1978).

The proper question is whether the Examiner found a suggestion or motivation to combine specific elements of the prior art to yield the present invention. The Examiner has provided no evidence of a suggestion to combine the cited references to result in the present invention. “No prior art provided a teaching or suggestion or motivation that a [device] should be made with the structure shown and claimed” in the instant application. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225 (Fed. Cir. 1998). Absent this essential

component of a prima facie case of obviousness, applicant respectfully requests that Examiner's rejection be withdrawn. *See id.*

The Examiner cannot use the invention to render itself obvious. "The invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art." *C.R. Bard*, 157 F.3d at 1352. The Examiner essentially lists the claim limitations and matches them with elements from the cited reference. "It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion or incentive to make the combination made by the inventor." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). No rationale is provided other than that disclosed in the application itself. The Examiner has combined elements from the cited reference, "using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Examiner essentially states that it would have been obvious for one skilled in the art at the time the invention was made to do exactly what the inventor did for exactly the reasons disclosed in the application. "The absence of a convincing discussion of the specific sources of the motivation to combine the prior art references . . . is a critical omission in [an] obviousness analysis." *Ecolochem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 1374, 56 USPQ2d 1065 (Fed. Cir. 2000). "[A] rejection cannot be predicated on the mere identification . . . of individual components of claim limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the

claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

“The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination.” MPEP, 7th Edition (1998), § 2143.01, p. 2100-112 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine the prior art references to achieve the present invention. “Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” *In re Dembiczak*, 175 F.3d at 999 (quoting *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).

The prior art must be considered in its entirety, including disclosures that teach away from the claims. It is error to find obviousness where references “diverge from and teach away from the invention at hand.” *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994).

The statutory standard for the determination of obviousness provides that a claimed invention is unpatentable “if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (emphasis added). Case law provides that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (emphasis added). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be “clear and particular,” and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” *See In re Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617.

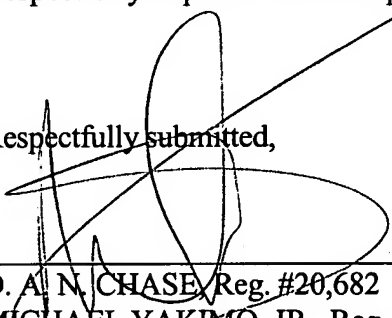
The Examiner has pulled a single reference from the prior art, Barbaccia . The Athletic Headwear Shaping device and method of the present invention provides a unique apparatus that was not obvious in view of the prior art, even if the individual elements used to comprise it were readily available, which the applicant respectfully denies that that the individual elements are in the prior art cited. “As a whole” the device was not obvious at the time of invention. The ultimate determination of obviousness should be based on the totality of the evidence, not a culling of elements pulled from a single reference to combine in a manner only disclosed and suggested by the application under review. *See In re Dembiczak*, 175 F.3d 994

generally and *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1131, 56 USPQ2d 1456 (Fed. Cir. 2000).

As discussed in detail hereinabove, applicant believes that the Examiner's obviousness rejection should be withdrawn as applied to the amended claims 1, 6-10 and accordingly to all claims depending therefrom. Additionally, application believes that the Examiner's rejection under 35 U.S.C. § 102 should also be withdrawn, as discussed in detail hereinabove.

Accordingly, applicant respectfully requests that this application be passed to allowance.

Respectfully submitted,



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